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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,646	01/25/2002	Harry R. Davis	CV01379K	3480
24265	7590	11/17/2004	EXAMINER	
SCHERING-PLOUGH CORPORATION PATENT DEPARTMENT (K-6-1, 1990) 2000 GALLOPING HILL ROAD KENILWORTH, NJ 07033-0530			WANG, SHENGJUN	
			ART UNIT	PAPER NUMBER
			1617	

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/057,646

Applicant(s)

DAVIS ET AL.

Examiner

Shengjun Wang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 7-30 and 32 is/are pending in the application.
- 4a) Of the above claim(s) 11-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7-10, 28-30 and 32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

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DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 30, 2004 has been entered.
2. Claims 11-17 are withdrawn from further consideration as drawn to non-elected species. (office action 11.13/2003).
3. The claims have been examined insofar as they read on elected invention and species.

Double Patenting Rejections

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4, 7-10, 28-30, 32 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7, 14-25 of copending Application No. 10/639900. Although the conflicting claims are not identical, they are not patentably distinct from each other because '900 claims a combination of HM74 agonist and a azetidinone compounds and the method of using the same for lowering cholesterol,

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wherein, ezetimibe and nicotinic acid derivative are specifically claimed. The claimed amounts of the azetidinone are 0.1 to 1000 mg. As to the specific amount of ezetimibe, note the amount (10 mg) is within the range disclosed by Rosenblun et al. In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a prima facie case of obviousness exists. In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); In re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990). Further, Optimization Within Prior Art Conditions or Through Routine Experimentation Generally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections 35 U.S.C. 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 1-4, 7-10, 28-30, 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenblum et al. (US 5,846,966, IDS), in view of Kim (US 5,698,527, IDS) and Keller et al (WO 00/38725, IDS).

7. Rosenblum teaches the instant cholesterol absorption inhibitors and its application for lowering serum cholesterol. Rosenblum further teaches that the cholesterol absorption inhibitors may be employed in combination with other cholesterol lowering agents, such as simvastatin. See, particularly, the abstract, and the claims. Rosenblum et al. teach that daily dosage of the compounds is about 5mg to 1000 mg, given in a single dose or 2-4 divided doses. When used in combination with other drug the dose is about 1mg to 1000 mg a dose given 1 or 2 times a day. The exact dose would depend on various conditions. See, particularly, col. 21, lines 17-63.

8. Rosenblum et al. do not teach expressly a combination of the cholesterol absorption inhibitor and nicotinic acid.

9. However, Kim teaches that nicotinic acid (niacin) is a well-known cholesterol lowering agents, and is particularly useful in combination with cholesterol absorption inhibitors. See, particularly, the abstract, and column 32, lines 9-25. Keller et al. teaches various combinations of cholesterol lowering agents, including ezetimibe and nicotinic acid, for treating hypercholesterol associated disorders. See, particularly, the abstract, and pages 11-14.

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed invention was made, to make a composition comprising ezetimibe and nicotinic acid, and optionally simvastatin.

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A person of ordinary skill in the art would have been motivated to make a composition comprising ezetimibe and nicotinic acid, and optionally simvastatin because it is prima facie obvious to combine two compositions each of which is taught in the prior art to be useful for same purpose in order to form third composition that is to be used for very the same purpose; idea of combining them flows logically from their having been individually taught in prior art; thus, the claimed invention which is a combination of two known cholesterol lowering sets forth prima facie obvious subject matter. See In re Kerkhoven, 205 USPQ 1069. Further, the prior art have suggested the usefulness of combination of different cholesterol lowering agents, particularly, cholesterol absorption inhibitor and nicotinic acid. As to the specific amount of ezetimibe, note the amount (10 mg) is within the range disclosed by Rosenblun et al. In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a prima facie case of obviousness exists. In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); In re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990). Further, Optimization Within Prior Art Conditions or Through Routine Experimentation Generally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

Response to the Arguments

Applicants' amendments and remarks submitted August 30, 2004 have been fully considered, but are not persuasive.

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10. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the teaching suggestion and motivation are found both in the cited references and in the knowledge generally available to one of ordinary skill in the art. Particularly, the references teach each of the components in the combination is known to be useful for the same purpose. Therefore, a prima facie case has been established (See *In re Kerkhoven*, 205 USPQ 1069). Further, each component has been taught to be used in combination with other therapeutical agent having hypocholesterolemic or hypolipidemic effects. Kim particularly teaches the combination of nicotinic acid with cholesterol absorption inhibitors. It would have been obvious to combine ezetimibe, a known cholesterol absorb inhibitor, with nicotinic acid since it is known to combine two different hypolipidemic agents in general, and a cholesterol absorption inhibitor with nicotinic acid in particular.

11. Whether the ergostanone is as effective as ezetimibe as a cholesterol absorption inhibitor is not relevant. Kim et al teach the usefulness of combination of cholesterol absorption inhibitors with other hypolipidemic agents, including nicotinic acid. Possessing this knowledge, one of ordinary skill in the art would have been motivated to use the cholesterol absorption inhibitor disclosed by Rosenblun et al to make a combination with nicotinic acid, as herein claimed. Keller is cited to provide further evidence that it is a common practice in the art to combine

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hypolipidemic or hypocholesterolemic agents with different mechanism to enhance the therapeutical effects.

12. If applicants believe, and have evidence supporting such believe, that the particular combination herein has superior and unexpected benefit over the combinations disclosed in prior art, applicants should come forward with those evidence, and clearly elaborate the unexpected benefit. Absent evidence of unexpected benefit, the claims would have been properly rejected over the prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang whose telephone number is (571) 272-0632. The examiner can normally be reached on Monday to Friday from 7:00 am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SHENGJUN WANG
PRIMARY EXAMINER

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Shengjun Wang
Primary Examiner
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